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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,550	11/14/2003	Timothy J. Flynn	CD-133	7978

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EXAMINER

PURVIS, SUE A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,550

Applicant(s)

FLYNN ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-39 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 15-21 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7-13, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings were received on 20 June 2005. These drawings are acceptable.

Response to Amendment

2. The indicated allowability of original claims 6, 14 (and as a result, new claim 1) is withdrawn in view of the newly discovered reference to Koch (US Patent No. 6,543,508 B2).

Rejections based on the newly cited reference follow.

3. Since this action is Non-Final, no interview was given as requested since the applicant has not had the opportunity to consider the new rejection. Applicant is free to call to request an interview if they wish to expedite the examination of this application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Applicant claims the "apparatus of Claim 1 comprising a mouse pad," however, the specification states "apparatus 10 can be utilized as

Art Unit: 1734

a mouse pad and/or a working or writing surface." The claim fails to achieve the structure as set forth in the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 6, 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Koch.

Regarding claim 1, Koch discloses an apparatus for transferring a label portion from a label assembly onto an object. Koch includes a base (10) with a stop wall (12) and an application area (13) which is bound by the stop wall (12). Koch also includes a first stripping member (15) which includes fingers as seen in Figure 1. The fingers extend from the stop wall (12) toward the application and are suspended there over to hold the disk separate from label prior to the labels application to the disk. (Col. 6, lines 19-37.) Koch also includes a second stripping member which acts as a hub (18). The member (18a) is at the end of the U-shaped slots (17) and are suspended over at least a portion of the application area (13). The label is positioned on the base between the first stripping member and the second stripping member. (See Figure 1.)

Regarding claim 2, the stripping members (15) around the periphery of the wall act as indexing elements.

Art Unit: 1734

Regarding claim 3, the side cavities (16a) shown in Figure 1 are opposing guides.

Regarding claim 6, the stripping member (18a) has separate opposing members as defined by the claim. (See Figure 1.)

Regarding claim 15, the device in Koch is made from plastic.

Regarding claims 16 and 17, the stop wall is integrated with the base and extends along at least a portion of the periphery of the base.

Regarding claim 18, the stripping members (15) are "integrated" with the wall (12) because there are made from the plastic and connected thereto.

Regarding claim 19, the wall is effectively "sloped."

Regarding claim 20, there is a gap between the stripping member (15) and the first surface of the application area, as well as between the second stripping member and the first surface. (See Figures 1 and 2.)

Allowable Subject Matter

9. Claims 24-39 are allowed.
10. Claims 4, 5, 7-13, 22, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments with respect to claims 1-3 and 15-21 have been considered but are moot in view of the new grounds of rejection.
12. Applicant's arguments, see page 17 of the Response, filed 20 June 2005, with respect to Claim 24 have been fully considered and are persuasive. The rejection of Claims 24-27 has been withdrawn.

Art Unit: 1734

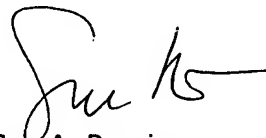
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clark et al. (US Patent No. 6,585,021 B2) is a reference of interest but does not disclose the features as claimed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
August 27, 2005